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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,046	01/25/2002	Katsumi Kanasaki	RCOH-1044	3429
7590 KNOBLE & YOSHIDA, LLC Suite 1350 Eight Penn Center 1628 John F. Kennedy Blvd. Philadelphia, PA 19103		08/19/2008	EXAMINER SERRAO, RANODHIL	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 08/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,046	<b>Applicant(s)</b> KANASAKI, KATSUMI
	<b>Examiner</b> RANODHI N. SERRAO	<b>Art Unit</b> 2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to the objection to the specification have been fully considered and are persuasive. Therefore the objection has been withdrawn.
2. Applicant's arguments with respect to the rejection of claims 1, 12, 21, and 22 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. Therefore the rejection has been withdrawn.
3. Applicant's arguments with respect to the rejection of claims 1, 21, and 22 under 35 U.S.C. 112, second paragraph have been fully considered but they are not persuasive. Applicant stated,

*Further more, also based upon the above disclosures, the Applicant believes that independent claims 1, 12 21 and 22 contain the patentable features that are particularly pointed out and distinctly claimed which the Applicant regards as the invention. Thus, the Applicant respectfully submit to the Examiner to withdraw the rejections of claims 1, 12 21 and 22 under 35 U.S.C. §112, Second Paragraph.*

4. The Examiner submits that the applicant did not particularly address the issues raised under 35 U.S.C. 112, second paragraph. Therefore the rejection is maintained.
5. Applicant's arguments with respect to the rejection of claims 21 and 22 under 35 U.S.C. 101, have been fully considered but they are not persuasive.
6. Applicant stated,

*Figure 1 of the current application discloses a "memory unit." It appears irrelevant whether or not the specification discloses as to what kind of a computer readable medium. The Applicant respectfully requests the Examiner to clarify the second ground of rejection under 35 U.S.C. § 101 with respect to the kind of a computer readable medium.*

7. The Examiner points out that "a computer readable medium" does not necessarily fit within any of the four statutory categories of patentable subject matter of § 101, and it is not limited to tangible embodiments. See MPEP 2105, section IV – Determine whether the claimed invention complies with 35 U.S.C. 101 - under subsection 1, nonstatutory subject matter. To overcome this type of 101 rejection, the examiner respectfully suggests applicant to amend the claim to include, "a computer readable storage medium."

8. Applicant's arguments with respect to the rejection of claims 1 and 22 under 35 U.S.C. 103, have been fully considered but they are not persuasive.

9. Applicant argued in reference to Taylor that the only existing mail addresses are stored, and no new mail addresses are "automatically" generated. The examiner respectfully submits that Taylor is not cited to teach this limitation, Holleran is. Holleran discloses, automatically generating a new address definition including a new address based upon the corresponding predetermined rule definition (*The computer system automatically parses the information contained in the address string into its appropriate field. See col. 8, lines 48-51. A user can have the address displayed either in a field or a string format. When information is changed in one view, it will be displayed correctly when the user switches to the alternate view. See col. 9, lines 8-11. A new address is generated automatically in the string format after the user inputs the data into an address definition see also fig. 12b).*)

10. Applicant stated,

*The Examiner has repeated the previous rejection bases in Paragraphs 16 through 34 of the pending Office Action. Because of the new grounds of*

*rejections that are not based upon prior art, the Examiner has failed to explain as to why the previously amended claims would not overcome the pending rejection bases. For this reason, the Applicant here below presents the previously submitted arguments to distinguish over the cited prior art references in the pending rejections.*

11. The examiner points out that these arguments have indeed been addressed in the Final Office Action mailed on 01 November 2007, see pages 2-4 under heading – Response to Arguments. The Applicant has reiterated these arguments from the Remarks mailed on 28 August 2007. The Examiner incorporates herein all responses from the Final Office Action mentioned above, and due to the indefinite nature of the claims as indicated by the rejection under 35 USC § 112, second paragraph, the cited prior art of record continue to teach the claimed limitations and the rejections are maintained.

#### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claims 1, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claim 1 recites, "a new address" multiple times in lines 7 and 8. Further in line 13, the claim recites, "the new address." It is vague and unclear which one of the new addresses "the new address" refers to. Furthermore the claim recites, **requesting** an address definition **from a second device** to a first device. Then recites, **returning the**

address definition containing a plurality of components to the second device **from the first device.** Emphasis added. If an address definition is requested from a second device, it should be returned from the second device not the first. The examiner fails to see how the address definition can be returned from the first device when the first device is requesting the address definition from the second device. This does not make logical sense. Therefore the claim is vague and indefinite.

15. Claims 21 and 22 recite similar language in regards to requesting an address definition. Therefore these claims are rejected as being indefinite.

#### ***Claim Rejections - 35 USC § 101***

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. There is no mention in the applicant's specification what "a computer readable medium" consists of.

18. The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value,

as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

***Claim Rejections - 35 USC § 103***

19. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
20. Claims 1, 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. (5,752,059) and Taylor et al. (5,754,306).
21. As per claim 1, Holleran et al. teaches a method of flexibly managing addresses for a communication system (see Holleran et al., col. 3, lines 26-52), comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including a new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65); and returning the newly generated address definition including the new address from the second address to the first device (see Holleran et al., col. 9, lines 13-23). But fails to teach generating a

new address definition based upon the corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions.

However, Taylor et al. teaches automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

22. As per claim 2, the above-mentioned motivation of claim 1 applies fully in order to combine Holleran et al. and Taylor et al. Taylor et al. and Holleran et al. teach a method of flexibly managing addresses for a communication system, wherein the addresses include e-mail addresses, document folders, telephone number and fax numbers (see Taylor et al., column 10, lines 28-34).

23. As per claim 12, Holleran et al. teaches a system for flexibly managing addresses for a communication system, comprising: a third device sending a request for an address definition for use with a predetermined operation; a second device connected to said third device for receiving the request for the address definition and sending the request for the address definition (see Holleran et al., col. 3, lines 26-52); and a first device connected to said second device for returning the address definition containing a plurality of components to said second device in response to the address definition request (see Holleran et al., col. 5, lines 40-64), said first device further including an address maintenance unit for maintaining address information (see Holleran et al., col. 4, line 55-col. 5, line 3); wherein said second device obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20) and automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition (see Holleran et al., col. 8, lines 46-65), said second device returning the newly generated address definition including the new address to said third device (see Holleran et al., col. 9, lines 13-23). But fails to teach wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions. However, Taylor et al. teaches wherein said second device obtaining predetermined conditions for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including some components

Art Unit: 2144

based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

24. As per claim 22, Holleran et al. teaches a computer readable medium storing computer executable instructions for performing the task of flexibly managing addresses for a communication system, the computer executable instructions comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65). But fails to teach obtaining a corresponding condition for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the newly

generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists. However, Taylor et al. teaches obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition (see Taylor et al., col. 24, lines 19-40); returning the newly generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Taylor et al., col. 29, lines 18-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the newly generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the

ID exists in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

25. Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. and Taylor et al. as applied to claim 1 above, and further in view of Krishnaswamy et al. (5,999,525).

26. As per claim 3, Holleran et al. and Taylor et al. teach the mentioned limitations of claim 1 above but fail to teach wherein the first device is an existing user account management unit for user account information. However, Krishnaswamy et al. teaches wherein the first device is an existing user account management unit for user account information (see Krishnaswamy et al., column 23, lines 37-47). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Taylor et al. and Holleran et al. to wherein the first device is an existing user account management unit for user account information in order to attach individual systems for billing, provisioning, directory services, messaging services such as voice messaging via a communication link (see Krishnaswamy et al., col. 23, lines 23-36).

27. As per claims 4, 10, and 11, the above-mentioned motivation of claim 3 applies fully in order to combine Holleran et al., Taylor et al., and Krishnaswamy et al.

28. As per claim 4, Holleran et al., Taylor et al., and Krishnaswamy et al. teach an address maintenance unit that corresponds to the existing user account management

unit for managing address information (see Krishnaswamy et al., column 23, lines 37-47).

29. As per claim 10, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein said generating the new address definition is performed prior to said requesting the address definition (see Krishnaswamy et al., column 108, lines 21-32).

30. As per claim 11, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein the address definition each has a unique ID and further comprises additional steps of determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Krishnaswamy et al., column 102, lines 50-67).

31. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnaswamy et al., Taylor et al., and Holleran et al. as applied to claims 1 and 4 above, and further in view of Ouchi (5,978,836).

32. As per claim 5, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by adding a new delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by adding a new delivery method (column 12, lines 46-65). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by

Art Unit: 2144

adding a new delivery method in order to go off route and capture the optimal route of transmission.

33. As per claim 6, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1, 4, and 5 as described above but fail to teach wherein the new delivery method is specified in the rule definition. Ouchi however teaches wherein the new delivery method is specified in the rule definition (column 8, lines 13-31). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the new delivery method is specified in the rule definition in order to insure that the value for the active document is unique.

34. As per claim 7, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1, 4, 5, and 6 as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value. Krishnaswamy et al., however teaches wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value (column 99, line 58-column 101, line 16: wherein VNET numbers serve the function of a Condition value, unique ID serves the function of an ID value, IP address serves the function of a Source value, a Name Generation Method value, and a Type Generation Method value). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the rule

definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value in order to allow an user to register his/her computer as "on-line" and available to receive calls.

35. As per claim 8, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by deleting an existing delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by deleting an existing delivery method (column 6, line 48-column 7, line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by deleting an existing delivery method in order to permit more than one concurrent use of a workflow route.

36. As per claim 9, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4, as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the address maintenance unit updates the address information based upon the user account information. Krishnaswamy et al. however teaches wherein the address maintenance unit updates the address information based upon the user account information (column 41, lines 27-35). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit updates the address information

based upon the user account information because cache copies must be refreshed when the version is out of date.

37. Claims 13-21 have similar limitations as to claims 1-12 and 22 above; therefore, they are being rejected under the same rationale.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/R. N. S./

Examiner, Art Unit 2141

08/13/2008

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144